

AMENDMENTS TO THE DRAWINGS:

The attached sheet of drawings includes an amendment to Figure 6. Applicants have added a "Prior Art" legend to the figure.

Attachments: Replacement Sheet: 1 sheet – Figure 6

REMARKS

Applicants respectfully acknowledge receipt of the Office Action mailed March 18, 2005.

In the Office Action, the Examiner (1) objected to the drawings under M.P.E.P. §608.02(g); (2) rejected claims 1-4, 8-17, and 21-27 under 35 U.S.C. §102(e) as being anticipated by *Ueda* (U.S. Patent No. 6,122,009); (3) rejected claims 5-7, 18-20, 28, and 30-37 under 35 U.S.C. §103(a) as being unpatentable over *Ueda* in view of *Toyoda et al.* (U.S. Pub. No. 2001/0012073); and (4) rejected claims 29 and 38 under 35 U.S.C. §103(a) as being unpatentable over *Ueda* and *Toyoda*, and further in view of *Basista et al.* (U.S. Patent No. 4,451,124).

By this Amendment, Applicants propose to amend claims 1, 2, 6-9, 12, 14, 15, 19, 20, 22, 23, 26, 28, and 37 to improve clarity and better define the claimed invention. Claims 1-38 remain pending. Of these claims, claims 1, 14, 28, and 37 are independent.

The originally-filed specification, claims, abstract, and drawings fully support the amendments to claims 1, 2, 6-9, 12, 14, 15, 19, 20, 22, 23, 26, 28, and 37. No new matter has been introduced.

Based on the foregoing amendments, Applicants traverse each of the above objections and rejections and respectfully request reconsideration for at least the reasons that follow.

I. OBJECTION TO THE DRAWINGS

The drawings stand objected in view of M.P.E.P. §608.02 (g). The Examiner asserts "Figure 6 should be designated by a legend such as -- Prior Art -- because only

that which is old is illustrated.” (*Office Action*, p. 2, ll. 1-7). Accordingly, Applicants have amended Figure 6 to add a “Prior Art” legend. Consequently, Applicants respectfully request the objection to the drawings be withdrawn.

II. 35 U.S.C. §102(e) REJECTION

Applicants submit that claims 1-4, 8-17, and 21-27 are patentably distinguishable over the cited references, including *Ueda*, and the other art of record. The cited prior art fails to disclose or suggest each element of the invention recited in independent claims 1 and 14. In particular, the applied references, taken alone or in combination, at least fail to teach or suggest an image pickup device attached to a base board, comprising: an image pickup element attached to the base board and including a photoelectrically converting section in which pixels are arranged, a peripheral surface formed around the photoelectrically converting section and a side surface adjoining the peripheral surface; and an optical member including a lens section to form an image of an object onto the photoelectrically converting section of the image pickup element, a leg section to support the lens section and a contact surface to be brought in contact with the image pickup element; wherein the lens section, the leg section and the contact surface are made in a single body, wherein a plurality of contact surfaces are provided, and wherein the optical member is mounted on the image pickup element such that the plurality of contact surfaces are arranged on a ring-shaped zone in contact with contact portions located on the peripheral surface between an edge of the peripheral surface and an edge of the photoelectrically converting section, as recited in proposed amended claim 1.

In addition, the cited prior art at least fails to teach or suggest an image pickup device attached to a base board, comprising: an image pickup element attached to the base board and including a photoelectrically converting section in which pixels are arranged, a peripheral surface formed around the photoelectrically converting section and a side surface adjoining the peripheral surface; an optical member including a lens section to form an image of an object on the photoelectrically converting section of the image pickup element, a leg section to support the lens section and a contact surface to be brought in contact with the image pickup element, wherein the lens section, the leg section and the contact surface are made in a single body; and a lens frame to retain the optical member; wherein a plurality of contact surfaces are provided, wherein the optical member is mounted on the image pickup element such that the plurality of contact surfaces are arranged on a ring-shaped zone in contact with contact portions located on the peripheral surface between an edge of the peripheral surface and an edge of the photoelectrically converting section, wherein the position between the lens section and the photoelectrically converting section of the image pickup element in the optical axis direction is determined by bringing the contact surface in contact with the peripheral surface or with a surface member when the surface member is provided on the peripheral surface, and wherein the position between the lens section and the photoelectrically converting section of the image pickup element in the direction perpendicular to the optical axis is determined by mounting the lens frame on the base board and by retaining the optical member with the lens frame, as recited in proposed amended claim 14.

Applicants note that in order to properly anticipate Applicants' claimed invention under 35 U.S.C. §102, each and every element of the claim in issue must be found, "either expressly or inherently described, in a single prior art reference." "The identical invention must be shown in as complete detail as is contained in the . . . claim.

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." See M.P.E.P. § 2131, 8th ed., 2001.

Ueda teaches wherein contact surfaces of leg portion (11) are arranged on a rectangularly-shaped zone located on the peripheral surface between an edge of the peripheral surface and in contact with the photoelectrically converting section (12) (emphases added). (*Ueda*, Figs. 8, 26, and 27). Accordingly, *Ueda* necessarily fails to teach or suggest the claimed combination including at least wherein "[a] plurality of contact surfaces [are] arranged on a ring-shaped zone in contact with contact portions located on the peripheral surface between an edge of the peripheral surface and an edge of the photoelectrically converting section," as recited in proposed amended claims 1 and 14 (emphases added). This limitation is depicted in Figs. 4 and 5, as contact surfaces (1d) are arranged on a ring-shaped zone, positioned between an edge of the peripheral surface and an edge of the photoelectrically converting section (2d). As discussed in the claimed invention, the four corner edges of the bare chip are poor in terms of surface accuracy, such as flatness and roughness, due to the cutting process in the production of the bare chip. Therefore, as shown in *Ueda*, when the contact surfaces of the leg are brought into contact with the corner edge, there is a problem of focusing and positioning an image at an appropriate position on the photoelectrically-converting section of the bare chip. (*Specification*, p. 5, line 8 – p. 6, line 9). For at

least these reasons, Applicants request that the rejection of claims 1 and 14 under 35 U.S.C. §102(e) be withdrawn and claims 1 and 14 be allowed.

Moreover, claims 2-13, and 15-27 are allowable at least due to their dependence from claims 1 and 14, respectively. In addition, at least some of the dependent claims recite unique combinations that are neither disclosed nor suggested by the cited art, and therefore some also are separately patentable.

III. 35 U.S.C. §103(a) REJECTION

Applicants respectfully submit that claims 5-7, 18-20, and 28-38 are patentably distinguishable over *Ueda*, *Toyoda*, *Basista*, and the other art of record at least for the reasons described below.

Applicants note that in order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must "be found in the prior art, and not be based on Applicants' disclosure." See M.P.E.P. §2143, 8th ed., February 2003.

The cited prior art fails to disclose or suggest each element of the invention recited in independent claims 28 and 37. In particular, the applied references, taken alone or in combination, at least fail to teach or suggest an image pickup device, comprising: a base board; an image pickup element provided on the base board and

including a photoelectrically converting section; an optical member including a lens section to form an image of an object on the photoelectrically converting section of the image pickup element and a leg section to support the lens section; and an elastic member to press the optical member toward the image pickup element with an elastic force; wherein the optical member is mounted on the image pickup element such that a plurality of contact surfaces are arranged on a ring-shaped zone in contact with contact portions located on a peripheral surface between an edge of the peripheral surface and an edge of the photoelectrically converting section, as recited in proposed amended claim 28.

In addition, the cited prior art at least fails to teach or suggest an image pickup device, comprising: a base board; an image pickup element provided on the base board and including a photoelectrically converting section; an optical member including a lens section to form an image of an object on the photoelectrically converting section of the image pickup element and a leg section to support the lens section; and a lens frame to support the optical member and having an elastic member to press the optical member toward the image pickup element with an elastic force; wherein the optical member is mounted on the image pickup element such that a plurality of contact surfaces are arranged on a ring-shaped zone in contact with contact portions located on a peripheral surface between an edge of the peripheral surface and an edge of the photoelectrically converting section, as recited in proposed amended claim 37.

Ueda teaches a CCD bare chip (12) disposed on a substrate (1). The CCD bare chip (12) converts condensed light by an image forming lens (4) disposed on a holder (2). The holder (2) is disposed on the substrate (1). (*Ueda*, abstract and Figs. 2-8). In

addition, as described above, *Ueda* discloses wherein contact surfaces of leg portion (11) are arranged on a rectangularly-shaped zone located on the peripheral surface between an edge of the peripheral surface and in contact with the photoelectrically converting section (12) (emphases added). (*Id.* at Figs. 8, 26, and 27). *Ueda*, however, necessarily fails to teach or suggest the claimed combination including “[a] plurality of contact surfaces [are] arranged on a ring-shaped zone in contact with contact portions located on the peripheral surface between an edge of the peripheral surface and an edge of the photoelectrically converting section...[and] an elastic member to press the optical member toward the image pickup element with an elastic force (emphasis added),” as recited in claims 28 and 37.

Thus, in order to cure the deficiencies of *Ueda*, the Examiner relies on *Toyoda* for its asserted disclosure of “an elastic member for absorbing the play of the holder.” (*Office Action*, p. 6, ll. 22-25). Applicants note, however, that *Toyoda* does not teach or suggest, among other things, “[a] plurality of contact surfaces [are] arranged on a ring-shaped zone in contact with contact portions located on the peripheral surface between an edge of the peripheral surface and an edge of the photoelectrically converting section,” as recited in proposed amended claims 28 and 37 (emphasis added). Accordingly, Applicants respectfully request that the rejection of claims 28 and 37 under 35 U.S.C. §103(a) be withdrawn.

Moreover, claims 29-36 and 38 are allowable at least due to their dependence from claims 28 and 37, respectively. As noted above, claims 5-7 and 18-20 are allowable at least due to their dependence from claims 1 and 14, respectively. In addition, at least some of the dependent claims recite unique combinations that are

neither disclosed nor suggested by the cited art, and therefore some also are separately patentable.

IV. CONCLUSION

Applicants respectfully submit that independent claims 1, 14, 28, and 37 are in condition for allowance. In addition, claims 2-13, 15-27, 29-36, and 38 are in condition for allowance at least due to their direct or indirect dependence from claims 1, 14, 28, and 37 respectively.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action. In view of the foregoing amendments and remarks, Applicants respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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David W Hill

Dated: June 20, 2005

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Attachments: 1 Replacement Sheet – Figure 6